

Application No. 10/081,478
Response Dated October 3, 2005
Reply to Office Action of September 8, 2005

REMARKS/ARGUMENTS

The Examiner has required in the Office Action dated September 8, 2005, that pursuant to 35 USC §121, the subject application be restricted to one of the alleged two "inventions" of Group I (Claims 1, 3-4, 6-8, and 11-16) and Group II (Claims 17-20). Responding thereto, Applicants hereby elect, with traverse, the Group I invention presently defined by Claims 1, 3-4, 6-8, and 11-16. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

The Examiner contends that the "invention" in Groups I (Claims 1, 3-4, 6-8, and 11-16) and Group II (Claims 17-20) are distinct as explained by MPEP §806.05 (h). The Examiner states that in the instant case, the method as claimed could be performed with a matrix having an upper surface/side seeded with soft tissue cells, and a bottom surface/side seeded with bone tissue cells. The Examiner further states that the method as claimed could be performed with a matrix having an upper surface/side comprising growth factors specific for soft tissue cells, and a bottom surface/side comprising growth factors specific for bone tissue cells.

Applicants respectfully believe that the restriction is improper. In the instant application, Group I claims are directed to an article for use in repairing bone tissue defects. Likewise, Group II claims are directed to a method of using the article defined in Group I claims for repairing bone tissue defects. More specifically, Claim 17, the only independent claim of Group II claims, recites the method comprising the steps of (a) providing an article defined in Claim 11 of the Group I, and (b) surgically applying the article. As the matter of the fact, the step (a) of Claim 17 of Group II has an identical recitation of the article of Claim 11 of Group I.

Applicants point out that the two matrix examples provided by the Examiner do not have limitations positively recited in Group I or Group II claims, therefore, the examples are not equivalent to the instant method of using the article for repairing bone tissue defects.

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Furthermore, a critical reading of the restriction requirements, as cited by the Examiner, finds that the two groups of claims do not meet the requirements for the restriction. More specifically, the requirement in MPEP 806.4 states that the Examiner needs to show that the two or more inventions are distinct and independent.

The Examiner is requested to reconsider the restriction requirement under 35 USC §121 to elect a single invention. The requirements of §121 are that the inventions be independent and distinct. Both requirements are necessary to maintain a restriction requirement. Applicants maintain that the Examiner has not focused upon the two requirements of being independent and distinct. It is noted that M.P.E.P. §802.01 provides a definition of independent as follows:

The term "independent" [i.e., not dependent] means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, [1] species under a genus which species are not usable together as disclosed or [2] process and apparatus incapable of being used in practicing the process.

Applicants contend that Groups I and II inventions are not independent of each other, because the article for use in repairing bone tissue defects is claimed in both Groups I and II.

Applicants have endeavored to particularly point out and distinctly claim their invention. Applicants submit that the embodiments identified by the Examiner would all be found in the same general search and hence would not require any undue searching by the Examiner. More particularly, the Examiner has indicated that both Groups would be found in Class 623. Furthermore, the search required for Group I is also required for Group II, because the same article is used in the method of Group II.

Notwithstanding, Applicants appreciate the Examiner's desire to separate the group inventions, but it is not readily understood that examining Group I and II inventions together would cause a serious burden on the PTO.

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On the other hand, the alleged two Group inventions resulting from the restriction requirement would cause Applicants additional expenses and time to prosecute separate patent applications. The burden placed upon Applicants for filing separate cases directed to each of the groups is respectfully submitted not to be outweighed by the burden placed upon the Patent Office by a coextensive examination of these groups in one application.

Applicants believe that it would be more efficient to examine all the claims rather than expend additional time prosecuting divisional applications relating to the specific Group I or Group II "inventions." Consequently, in the interest of efficiency, it is respectfully submitted that the restriction requirement is untenable and ought to be withdrawn as to Groups I and II.

For the above reasons, reconsideration of the restriction requirements for the alleged two Group inventions set for the in the outstanding Office Action is respectfully requested.

10/3/2005
Date of Signature

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